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Patent  
Attorney's Docket No. 016660-167



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Patent Application of ) **MAIL STOP AMENDMENT**  
Wing Chung Joseph Lau et al. )  
Application No.: 10/648,332 ) Group Art Unit: 3724  
Filed: August 27, 2003 ) Examiner: Clark F. Dexter  
For: ELECTRIC FOOD SLICER ) Confirmation No.: 5340  
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**RESPONSE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants traverse the Restriction Requirement set forth in the Office Action dated June 8, 2005.

First, it is noted that the Restriction Requirement is only directed to the *dependent* claims. All of these claims depend from a *single* independent claim. Thus, all the claims are based upon a common inventive concept, and the Office Action has not shown that this inventive concept is unpatentable. Consequently, there is no sound basis for requiring restriction at this stage of prosecution. If the prior art forces cancellation of the generic claim, restriction can always be imposed at a later time when two or more patentably distinct inventions are being independently claimed.

Second, the Office Action does not provide proper support for the claim groupings. Group I, comprising claims 2, 8 and 9, is characterized as being drawn to slicing apparatus with a specific housing configuration. The Office Action states that

this subject matter is classified in class 83, subclass 707. However, subclass 707 is entitled "Work Rectangularly Reciprocated Through Tool Station." The definition for this subclass states that it is directed to a device wherein the infeed means moves the work back and forth in a straight line past a cutting zone. The claims do not recite, nor are they otherwise limited to, a reciprocated slicer. Hence, the alleged classification has no relationship to the claimed subject matter. As stated in the Office Action, the claims are drawn to a specific "housing" configuration. As such, they fall within the definition of class 83, subclass 859, which is directed to a "device including a structural unit or *housing* which provides an environment for a cutting tool." (emphasis added) Consequently, the subject matter of Group I is classifiable in the same area as the subject matter of Group III.

Third, the Office Action has not shown that a serious burden would be imposed on the Examiner by examining the claims of multiple groups within the same application. As noted above, the claims of Group I are characterized as being drawn to a slicing apparatus with a specific housing configuration. This housing configuration is generically recited in independent claim 1. The subject matter of Group III is characterized as being drawn to a slicing apparatus with a specific material designation. Again, the material designation is generically recited in claim 1. Consequently, a full and complete search of the subject matter of claim 1 to find the best prior art would necessarily encompass the fields of search pertinent to the claims of each of Groups I and III. As such, there is no serious burden on the Examiner to examine all of these claims together in the same application.

For at least the foregoing reasons, it is respectfully submitted that the Restriction Requirement is both untimely and improper, and therefore should be

withdrawn. However, in order that this response be considered complete, Applicants provisionally elect the subject matter of Group II in the event that generic claim 1 is not found to be allowable.

Respectfully submitted,

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